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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

JACKSON, CORNELIUS H

ART UNIT PAPER NUMBER

2828

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,649

Applicant(s)

MCDONALD ET AL.

Examiner

Cornelius H. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 6) ☐ Other:

DETAILED ACTION

Acknowledgment

1. Acknowledgment is made that applicant's pre-Amendment, filed on 04 June 2002, has been entered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda et al. (4947398). Regarding claim 1, Yasuda et al. disclose an optical tuning apparatus **Fig. 4**, comprising: (a) a first tunable wavelength selection element **4** positioned in a light beam and having a first adjustable free spectral range; and (b) a second tunable wavelength selection element **5** positioned in said light beam and having a second adjustable free spectral range; (c) said first and second tunable wavelength selection elements configured to define a joint free spectral range operable to tune said light beam, **see Figs. 3a-c and 5, col. 4, lines 10-60 and col. 10, line 45-col. 12, line 34.**

Regarding claim 2, Yasuda et al. disclose said first and second tunable wavelength selection elements define a joint transmission peak that is adjustable according to tuning of said first and second tunable wavelength selection elements, **see Figs. 3a-c and 5.**

Regarding claim 3, Yasuda et al. disclose a gain medium **1** having first and second facets and emitting said light beam from said first facet, said gain medium having a free spectral range, **see Figs. 1 and 4.**

Regarding claims 4-6, Yasuda et al. disclose said joint free spectral range is at least as great as a gain bandwidth of said gain medium **1** and all the other stated limitations, **see col. 4, lines 27-42**.

Regarding claim 7, Yasuda et al. disclose a reflective element **3** positioned in said light beam after first and second tunable wavelength selection elements **4,5**, said reflective element **3** and said second facet of said gain medium **1** defining an external cavity laser.

Regarding claims 8-10, Yasuda et al. disclose what said first and second tunable wavelength selection elements may comprise of, **see col. 1, lines 7-13, col. 9, line 42-col. 10, line 9 and col. 11, lines 4-11**.

Regarding claims 11 and 12, Yasuda et al. disclose at least one of said first and second etalons is thermo-optically tunable or electro-optically tunable, **see col. 4, line 48-col. 11, line 40 and col. 18, line 23-col. 19, line 11**.

Regarding claims 13-15, Yasuda et al. disclose all the stated limitations, **see Figs. 3a-c and 5, col. 4, lines 10-60 and col. 10, line 45-col. 12, line 34**.

Regarding claims 16-18, Yasuda et al. disclose all the stated limitations, **see col. 10, line 45-col. 12, line 34**.

Regarding claim 19, Yasuda et al. disclose a tuning apparatus for a light beam, comprising (a) a first tunable wavelength selection element **4** positioned in said light beam, said first tunable element configured to define a first plurality of transmission peaks; (b) a second tunable wavelength selection element **5** positioned in said light beam, said second tunable element configured to define a second plurality of

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transmission peaks; (c) said first and second pluralities of transmission peaks defining a single joint transmission peak within a selected wavelength range, **see Figs. 2a-3d and 5**; and (d) said first and second tunable wavelength selection elements operable to adjust said joint transmission peak according to adjustment of said first and second tunable elements, **see col. 4, lines 10-60 and col. 10, line 45-col. 12, line 34**.

Regarding claim 20, Yasuda et al. disclose a gain medium **1** having first and second facets and emitting said light beam from said first facet, said gain medium **1** having a free spectral range.

Regarding claims 21-39 and 52-54, see corresponding claim rejection above.

Regarding claims 40-51, the method of forming a device is not germane to the issue of patentability of the device itself. Therefore, the rejection used against the device, stands for the method as well.

Conclusion

6. Note that claims 1-17, 19-34 and 36-54 of this application conflict with claims 1-28 and 33-36 of Application No. 10/087728 and claims 88, 89, 91, 92, 97-99 and 101-125 of Application No. 09/626526. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application

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or maintain a clear line of demarcation between the applications. See MPEP § 822.

Also see Zorabedian et al. (6282215)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (703) 306-5981. The examiner can normally be reached on 8:00 - 5:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



chj
July 28, 2003



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